

REMARKS

Paragraph 1 of the Office Action

5 Claims 5, 9 and 10 are rejected under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 10 have been cancelled, and claim 5 has been amended to correct the informality.

Withdrawal of the rejection is respectfully requested by the applicant.

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Paragraphs 2-6 of the Office Action

Claims 1 and 4-9 are rejected under 35 USC §102(b) as being anticipated by Chrietzberg. Claims 2, 3, 10 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chrietzberg et al.

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Claim 1 has been amended to include the limitations of the material being water buyout and that a well extends into the side of the base. The well allows for the storage of the cracking member when not in use so that it does not pose a danger while the material is important as applicant's device would be used frequently on a boat.

20 As to Chrietzberg, it is respectfully submitted that the Examiner has made multiple mischaracterizations to the elements found therein and to the standard meanings of words. First, it cannot be found, under any circumstance, that Chrietzberg might have contemplated the sign bracket to be used for cracking crabs. However, applicant clearly intended this usage and therefore has specific measurements which are useful for that purpose. The Examiner makes the statement that, "The Examiner considers claimed
25 dimensions to be *more directed to aesthetics* than a patentably distinct feature, and as such, will not be given patentable weight." (emphasis added) Aside from the fact that this is not the law, applicant chose specific dimensions based on the ease of cracking a crab and these dimensions have absolutely nothing to do with aesthetics. Chrietzberg did not contemplate these dimensions and the dimensions chosen by applicant serve a
30 distinct, before unrealized purpose, and therefore the dimensions are patentably distinct.

Second, as to the materials presented, the applicant, as previously stated, has chosen a buoyant material because of the risk that the device may fall into the water. The Examiner has made the statement that Chrietzberg mentions plastic, some plastics float, therefore, Chrietzberg must somehow include buoyant material. Inference is not the law. Chrietzberg must suggest the limitation and it cannot be assumed that Chrietzberg ever contemplated a buoyant material. In fact, Chrietzberg is a sign holder for buildings. One studying Chrietzberg would never be directed toward buoyant materials. Why would a sign positioned on a building need to be buoyant? The only conceivable way the Examiner could have found such an inference was by using applicant's claim language as a template to search for such a material. This again is contrary to the law. The suggestion must be found in the prior art itself and the Examiner cannot rely upon applicant's claims in order to find the missing link.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Additionally, that the modification could be made is not enough again without prior art suggestion.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original). Finally, on this same point, Chrietzberg does not state, as the Examiner claims, that the base be made of a plastic material. In fact, Chrietzberg alludes to a different

material for the base as the plastic is being used for the sleeve 44 because it is a "flexible material." Column 2, line 69. The flexible material is being used so that it will bias the sign against the base and, thereby, frictionally holds the sign in place. If the base were also made of a plastic material, the sign would not be held in place because of the flexibility imparted upon it by Chrietzberg. Thus, Chrietzberg actually speaks against a plastic base.

Third, as to the well used by the applicant, the Examiner points to an unnumbered area of Chrietzberg. Aside from making this difficult for applicant to know what element of Chrietzberg is being referenced, how can Chrietzberg suggest an element when none is referenced? However, the Examiner does state that the well is basically the bottom of Chrietzberg's base between the feet. If the well is the bottom, then how can it extend into the side wall as stated by applicant as applicant's device also includes feet which are separately defined with respect to the well. The definition of a well, according to Microsoft Bookshelf 98 is: An enclosed space for receiving and holding something, such as the wheels of an airplane when retracted. Chrietzberg shows no such enclosed space and thus there is no well shown. A slot perhaps, but not a well. Therefore, this element is also missing from the Examiner's citation.

Fourth, applicant states a flange that is attached to and orientated perpendicular to the plate, as well as a coupler having vertical and horizontal areas for receiving the flange and the plate. The Examiner states that element 44 is a flange orientated horizontal to the sign. As mentioned above, element 44 is a sleeve, not a flange, which extends along the edge of the sign and frictionally attaches it to the base. This is a different construction than that of applicant and is based on different structural requirements. A sign must have strength perpendicular to its opposing faces, but not toward its perimeter edge. This is because wind will place force only on the faces but not on the perimeter edge. Chrietzberg's coupling sleeve is weak against forces pushing, for instance, on the perimeter edge of the sign, but is strong against forces pushing perpendicular to the faces. That structure, however, will not work for applicant's device because striking forces on the perimeter edge while cracking a crab will cause the plate to bend and/or place upward force at the corners in the coupler. If Chrietzberg's structure were used, this action would pop the corners out of the coupler and make applicant's device ineffective. Also, with

respect to the structure, Chrietzberg does not state a flange that extends perpendicularly outward, but includes a pair of legs which are abutted against opposite sides of a sign. The legs do not extend outwardly from each other but in the same direction and are coplanar with the sign. Finally, there is no coupler found in Chrietzberg which includes
5 horizontal and vertical slots adapted for receiving the flange and the plate.

For all of the above reasons, it is simply unforeseeable that Chrietzberg could read upon applicant's device, and it is believed that independent claims 1 and 11, as well as all remaining claims depending from claim 1, are in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

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New Claims 12-23

New claims 12-23 have been added to vary the scope of the claims. All references therein are fully supported in the specification and claims as originally filed and no new matter has been added. For the reasons stated above and additionally for the
15 added element of a crab to claim 13, which is not suggested in Chrietzberg, it is believed that claims 12-23 are in condition for allowance.


CONCLUSION

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Date: 3/8/05

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